

### **REMARKS**

Claims 20-24 and 28-33 remain pending in this application. Claims 20, 23, and 30 are independent. No claims have been amended, added, or canceled by this Response.

### **Priority Claim**

The Official Action states that if Applicant desires to obtain the benefit of foreign priority under 35 U.S.C. §119(a)-(d) prior to declaration of an interference, a certified translation of the priority application must be submitted in reply to the Official Action, and that failure to provide a certified translation may result in no benefit being accorded for the non-English application.

Applicants respectfully traverse the requirement, and point out that this application is a National Stage application under 35 U.S.C. §371 and, as such, 35 U.S.C. §119 is not relevant. Neither a certified copy of the priority application nor a certified translation is necessary to assert a claim of priority since the International Bureau received a copy of the priority application during the International Phase of this application and copies are not required to be provided to the Elected Offices (US/EO) under the PCT Rules.

### **Written Description Rejection Under §112¶1**

Withdrawal of the rejection of claims 20, 23, 29, and 30 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement, is requested.

The Official Action indicates that support for the added language to various claims cannot be ascertained because an English translation of the Specification has not been received.

Applicants filed a certified translation of PCT/DE00/03506 with the Response to Missing Requirements on August 28, 2002. A review of PAIR has revealed that the translated Specification is included as part of the document labeled "Transmittal to TC". As such, a substitute Specification is not required.

Applicants assert that the translated Specification includes sufficient support under 35 U.S.C. §112, first paragraph, for the term “digital currency depot.” Accordingly, withdrawal of the rejection to claims 20, 23, 29, and 30 is requested.

### **Objection to Claim 22**

Withdrawal of the objection to claim 22 is requested. Claim 22 is a hybrid dependent method claim that includes the step of “using” the security module of claim 20, along with other recited steps to produce a forgery-proof document.

The claim language suggested in the Official Action is not understood and is believed to be inappropriate. Applicants believe that adoption of that language would result in indefiniteness because claim 20 is in fact an apparatus claim, and not a method claim.

Applicants’ formulation of the hybrid method claim 22 is submitted as being completely appropriate, definite, and in accord with long-standing patent practice as a “method of use” claim.

Accordingly, reconsideration of the objection to claim 22 is requested.

### **Anticipation Rejection By Elsner**

The details of the Official Action indicate that claims 20-24 and 28-33 are rejected under 35 U.S.C. §102(b) as being anticipated by Elsner (US 5,150,409). However, the Official Action also indicates that claims 30-33 would be allowable if rewritten in independent form. For this reason, Applicants presume that the anticipation rejection of claims 30-33 is merely the result of a typographical error.

At the outset, Applicants note that anticipation requires the disclosure, in a prior art reference, of each and every limitation as set forth in the claims.<sup>1</sup> There must be no difference between the claimed invention and reference disclosure for an anticipation rejection under 35

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<sup>1</sup> *Titanium Metals Corp. v. Banner*, 227 USPQ 773 (Fed. Cir. 1985).

U.S.C. §102.<sup>2</sup> To properly anticipate a claim, the reference must teach every element of the claim.<sup>3</sup> “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference”.<sup>4</sup> “The identical invention must be shown in as complete detail as is contained in the ...claim.”<sup>5</sup> In determining anticipation, no claim limitation may be ignored.<sup>6</sup>

### *Discussion of Elsner*

Elsner purports to disclose an apparatus and a method for the identification and encrypting/ decrypting of messages that permits converting an input message provided as characters, in character-by-character fashion and depending on preceding characters, to form an output message. An address branching network is employed for encrypting/decrypting. The address branching network includes selectable branches that are carriers of encrypting/decrypting characteristics. The selection of such branches is done in a step-by-step selection run through the branching network to convert any specific input message of optional length character-by-character into a specific selection path through the branching network. The output message is formed on the basis of the encrypting/decrypting characteristics from the branches selected on said selection path.

Elsner's invention is asserted as relating to a method and apparatus suitable as a universally applicable, permanently stable, space-saving and relatively inexpensive device for the purposes of identification and/or identity-related information coding, *i.e.*, encoding/decoding. Coding is achieved by means of individual data carriers which serve both for identification and as a key source. Elsner's invention requires only one individual data carrier which, once produced, is able to cover the requirements of person-related applications, such as finger prints.

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<sup>2</sup> *Scripps Clinic and Research Foundation v. Genentech, Inc.*, 18 USPQ2d 1001 (Fed. Cir. 1991).

<sup>3</sup> See MPEP § 2131.

<sup>4</sup> *Verdegaal Bros. v. Union Oil Co. of Calif.*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

<sup>5</sup> *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

<sup>6</sup> *Pac-Tex, Inc. v. Amerace Corp.*, 14 USPQ2d 187 (Fed. Cir. 1990).

Elsner at least does not teach or suggest use of a secret generator that generates an unpredictable secret, a hash machine that generates and outputs an irreversible hash value responsive to an output of the second combination machine, or any requirement that a forgery-proof document be produced only if actual sums of money are available to the digital currency depot, as further discussed below.

### *Specific Deficiencies of Elsner*

The applied art does not disclose a security module suitable for use with a digital currency depot for producing a forgery-proof document, wherein the module includes, among other features, "...a secret generator that generates an unpredictable secret; a first combination machine arranged to combine an output value of the identification register and an output value of the secret generator...a second combination machine that combines the unpredictable secret and input data received via an inlet valve; a hash machine that generates and outputs an irreversible hash value responsive to an output of the second combination machine; and means for ensuring that the forgery-proof document is produced only if actual sums of money are available to the digital currency depot", as recited in independent claim 20.

None of these limitations are disclosed in the cited portions of Elsner or elsewhere in the applied art, particularly the recited "hash machine" and "means for ensuring that the forgery-proof document is produced only if actual sums of money are available to the digital currency depot."

Further, the applied art does not disclose a method for producing a forgery-proof document, which includes, among other features, "...using the combined secret and input data to form an irreversible hash value; interfacing with a digital currency depot; and ensuring that only sums of money actually available to the digital currency depot are used to produce the forgery-proof document", as recited in independent claim 23.

Accordingly, since the applied art does not disclose each claimed limitation of independent claims 20 and 23, reconsideration and allowance of claims 20-24, 28, and 29 are respectfully requested.

**Allowable Subject Matter**

Applicants note with appreciation the indication that claims 30-33 would be allowed if rewritten into independent form due to their asserted reliance upon a rejected base claim. Applicants note that claim 30 is already in independent form, and that claims 31-33 depend therefrom. Thus, these claims should be allowed. Accordingly, allowance of claims 30-33 is respectfully requested.

**Conclusion**

In view of the above remarks, Applicants believe that each of pending claims 20-24 and 28-33 in this application is in condition for allowance. An early indication of the same would be appreciated.

In the event the Examiner believes an interview might serve to advance the prosecution of this application in any way, the undersigned attorney is available at the telephone number indicated below.

A request for one month extension of time is hereby requested pursuant to 37 C.F.R. §1.136(a) and a one month extension fee has been paid. Applicant believes no additional extensions or fees are due with this response. However, if an additional extension is needed or a fee is due, please consider this a request therefor and charge our Deposit Account No. 03-2775, under Order No. 10096-00001-US from which the undersigned is authorized to draw.

Respectfully submitted,

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By: \_\_\_\_\_

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